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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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LATHROP & CLARK LLP
740 REGENT STREET SUITE 400
P.O. BOX 1507
MADISON, WI 537011507

EXAMINER

HALPERN, MARK

ART UNIT PAPER NUMBER

1731

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,658

Applicant(s)

LAAPOTTI, JORMA

Examiner

Mark Halpern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-37 is/are allowed.
- 6) ☒ Claim(s) 38-52 and 54 is/are rejected.
- 7) ☒ Claim(s) 53 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4/22/02 6) ☐ Other: _____

DETAILED ACTION

- 1) Acknowledgement is made of preliminary Amendment received 11/13/2001.

Applicant cancels claims 1-23, and offers new claims 24-54, for consideration.

Specification

- 2) The amendment filed 11/13/2001, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The incorporation by reference of the disclosure of the PCT, Swedish and US Provisional applications into the specification (see paragraph [0001] of the substitute specification filed 11/13/01) is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3) Claims 48, 54, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 48 recites the limitation "blowing boxes" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 54: in line 2, is not clear as to what is meant by phrase "the cc distance"

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4) Claims 38-51, are rejected under 35 U.S.C. 102(b) as being anticipated by Justus (4,461,939).

Claims 38-42: Justus discloses a web being formed on a Fourdrinier wire or on a twin wire machine (col. 2, lines 10-15). The web is transferred to position W-3, where it is sandwiched between upper felt 13 and lower felt 16, the web is passes through nip N-1 formed between upper roll 20 and lower roll 21. Both rolls 20 and 21 are open rolls. The web is then passed to double felts 22 and 25 with the web being sandwiched there between and passes into nip N-2, formed by an open roll and a press shoe 31. Forces and pressures are impacting the web at the nips (col. 2, line 16 to col. 3, line 5). The web is then passed for drying by dryer drums (col. 3, lines 20-24). This reads on claimed machine having a wet section, a press section and a drying section. The instant claims are apparatus claims. Apparatus claims must be structurally distinguishable from the prior art. Manner of operating the device does not differentiate

apparatus claims from the prior art. MPEP 2114. In the present invention, the grammage of the paper being formed, the speed of the machine operation, linear load and specific pressures subjecting the web at the roll press nip and shoe press nip, and the dewatering rates after each nip are not of consideration and no patentable weight is imparted to the claims since they are method and not apparatus structural limitations.

Claim 43: suction shoe 19 is located right after nip N-1; suction roll 23 transfers the web from felt 16 onto felt 22 prior to nip N-2, as shown in Figure of Justus.

Claim 44: the web is sandwiched between the felts prior to reaching the shoe-press nip as shown in Figure of Justus.

Claim 45: suction shoe 29 is located right after shoe press nip N-2, as shown in Figure of Justus.

Claims 46-47: the shoe is constructed with an impervious belt 39, (in a lower position) which is lubricated to be smooth by lubricating supply means 38 (col. 2, lines 59-68).

Claims 48-49: suction roll 23 is arranged in the loop that carries the web to shoe press nip N-2, as shown in Figure of Justus. Said suction roll performs the same role as does a blowing box that generates vacuum. Suction roll 23 assists in the web transfer to the felt 22 where the shoe press nip is located.

Claims 50-51: the upper and lower felts 13 and 16 where the press roll is located enclose the web between them in a sandwich construction until the suction roll 23, as shown in Figure of Justus. The upper and lower felts 22 and 25 where the shoe press

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nip is located enclose the web between them in a sandwich construction until the shoe press nip.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) Claims 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Justus.

Justus is applied as above for claim 38, Justus discloses that the rolls 20 and 21 are constructed with grooves (col. 2, lines 36-40), Justus however is silent in regard to the surface of the rolls being made of steel material. It would have been obvious, to one skilled in the art at the time the invention was made, that the rolls be constructed of steel since the rolls must withhold forces and pressures experienced in the nip position in order to maintain water removal from the web. The volumetric flow through the grooves is not of consideration and no patentable weight is imparted to the claims since it is a method and not apparatus structural limitation.

Allowable Subject Matter

6) Claims 24-37, are allowed.

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7) Claims 53-54, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for indicating allowable subject matter is that the cited prior art does not show:

a method for manufacturing printing paper or paperboard, wherein a web formed in the wet section is pressed in a roll press nip and thereafter pressed in a shoe press nip, respectively, where said web is subjected at linear loads and specific pressures claimed, and where the web is dewatered to a dry-solids content at each of the stages claimed (claim 24);

a paper machine for manufacturing printing paper or paperboard, said machine includes open press rolls having grooves of volume, width and depth and distances between adjacent grooves claimed (claims 53-54).

Conclusion

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

MH

Mark Halpern
Patent Examiner
Art Unit 1731


STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700